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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,152	09/22/2003	Reinhold Schmieding	A8130.0140/P140	5784

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EXAMINER	
WILLSE, DAVID H	

ART UNIT	PAPER NUMBER
3738	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/665,152	SCHMIEDING, REINHOLD	
	Examiner	Art Unit	
	Dave Willse	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *10-14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9-22-03 (1 page)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The Applicant's election of Invention I in the reply filed on April 11, 2006, is acknowledged. Because the Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Oka et al., US 5,314,478, which discloses selecting an implant from a plurality of preformed implants, each implant having an articular surface formed on either end (Figures 3(a) through 3(e)), and inserting the implant into a recipient socket (Figure 4). [Note: the term "articular" means "[r]elating to a joint" *(Stedman's Medical Dictionary, 26th edition)*, and the intervertebral disc is an example of a cartilaginous joint.] Regarding claims 2-5, reference is made to column 8, lines

41-49; the (metallic) titanium fiber mesh bodies **1** and **11** are viewed as suture nets (instant claim 3) and define perforated surfaces (instant claim 4).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al., US 5,314,478. Laparoscopic or endoscopic emplacement of spinal implants was well known at the time of the present invention and would have been obvious to the ordinary practitioner in order to minimize the incision size.

Claims 1, 7, and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cerundolo, US 6,488,033 B1., which discloses creating a recipient socket in bone (Figures 7A, 8A, and 8B; column 2, line 67, through column 3, line 16), selecting an implant from a plurality of implants (column 4, lines 24-28; column 1, lines 39-41) preformed prior to insertion (column 3, lines 65-67), and inserting the implant into the recipient socket (Figure 14; column 4, lines 1-8). Regarding claim 7: Figure 12. Regarding claim 8, under an alternative interpretation, the opposing ends of each plug are *collectively* provided with *an* articular surface.

Claims 1, 2, 4, 6-9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Simon et al., US 2001/0039455 A1. Regarding claim 1 and others: paragraphs **0108** and **0145**. Regarding claim 2: paragraphs **0109** and **0121**. Regarding claim 4: paragraph **0096**; Figure 8A; etc. Regarding claim 6: Figure 9G; paragraph **0150**.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,713,374: abstract; column 3, lines 39-41; Figures 2-4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Dave Willse
Primary Examiner
Art Unit 3738